

REMARKS

I. Status of the Application

Claims 1-31 and 65-98 are pending. Claims 19, 28, 68, 79, 81, 83, 87, and 90-95 are amended. Claim 80 is cancelled without prejudice. Claims 1-18, 65, 84, 85, 96, and 97 have been allowed. Claims 70-78, 80-82, 86-88, and 95 have been objected to.

The Examiner is thanked for discussing the Office Action, the allowable and rejected claims, the prior art, and possible claim amendments with the undersigned attorney on December 29, 2006. No agreement was reached. The Interview is also discussed further, below.

II. Claim Rejections

A. U.S. Patent No. 5,432,499A (“Ferut”)

Claims 19-31, 31, 66, 67, and 89 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,432,499A (“Ferut”).

1. Independent Claim 19

The Examiner has asserted that use of the term “adapted” does not result in a positive limitation, citing In re Hutchison, 69 USPQ 138 (CCPA 1946). In re Hutchison only holds that in the claim at issue, the adapted element is not a positive limitation. According to MPEP § 2111.04, the interpretation of terms such as “adapted” depends on the facts of each case. It is believed that it is clear from the prosecution history of the present application that the “adapted” element is meant to be a positive limitation. However, to advance prosecution, independent claim 19 has been amended to change “at least one of the first and second ends being adapted to be mechanically connected to” an MRI system, to “at least one of the first and second ends being configured” to be so connected. As discussed in the Amendment filed on May 1, 2006, Fig. 3 of

the present application shows one end of the fixture having openings 136 for receiving bolts to connect the test fixture of the present application, to one pole of the MRI system.

The Examiner indicated in the phone conversation of December 29, 2006, that use of the term “configured” could result in the element being a positive limitation and could distinguish the prior art. Claim 95, which is dependent on claim 19, has also been amended to change “adapted” to “configured.” Since the “adapted” element was a positive claim limitation, as discussed above, these amendments do not narrow the scope of these claims.

In Ferut, in contrast, the test fixture 50 sits on a table cradle 18 within the interior volume 14 of the MRI system 10, as shown in Fig. 4 and described in column 4, lines 48-52. The mounting plate 54, which the Examiner considers to be a body portion, is clamped to the table cradle 18. (*Id.*) No structure is provided on the fixture to facilitate such clamping. The body portion in Ferut is not, therefore, configured to be mechanically connected to the table, as claimed.

In addition, as was discussed in the May 1, 2006 Amendment, the mounting plate 54 in Ferut does not have first and second ends along a longitudinal axis of a body portion of the fixture, at least one of which is adapted to be mechanically connected to the MRI system, as claimed. The Examiner asserts that the first and second ends are the top and bottom of the fixture 50. However, the top and bottom of the fixture are not “along” a longitudinal axis of the fixture. The axis 51 identified by the Examiner is not a longitudinal axis of the fixture 50. The ordinary meaning of “longitudinal” is “1: placed or running lengthwise 2: of or relating to length or the lengthwise direction.” (Merriam Webster’s Collegiate Dictionary, Tenth Edition, Merriam-Webster, Incorporated, Springfield, Massachusetts, 2001, p. 685, a copy of which was provided with the May 1, 2006 Amendment). The longitudinal axis of the fixture 50 in Ferut is

perpendicular to the axis 51 in Fig. 1, along its length. Regardless, no end of the Ferut fixture is configured to be mechanically connected to the MRI system, as claimed.

Claim 19 and the claims dependent upon it are not, therefore, anticipated by Ferut.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

2. Independent Claim 28

Independent claim 28 has been amended to require that “a first portion of the body portion is configured to be mechanically connected to the magnetic resonance imaging system.” Claim 28 has also been amended to remove the amendments made in the May 1, 2006 Amendment, which are not believed to be necessary in light of the other amendment. Dependent claim 87 has been amended to be consistent with amended claim 28 and to change “adapted” to “configured.” As discussed above, since it is clear from the prosecution history that the adapted element was meant to be a positive claim limitation, this amendment does not change the scope of the claim.

Amended claim 28 and the claims dependent upon it should, therefore, be allowable.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

B. Claims 79 and 83

Claims 79 and 83 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,099,459 (“Jacobson”). It is noted that the Examiner indicated that the patent number of Jacobson is 5,432,449 A, which is the patent number of Ferut, discussed above. It is assumed that the Examiner is referring to U.S. Patent No. 6,099,459. If that is not the case, please clarify the rejection.

Independent claim 79 has been amended to incorporate the limitations of claim 80, which has been found to contain allowable subject matter. Claim 79 has also been amended to remove the amendments made in the Amendment filed on May 1, 2006. The Examiner had found that claim 80 would be allowable if rewritten as an independent claim including the limitations of claim 79, in the Office Action dated November 1, 2005, prior to those amendments being made.

Amended claims 79 and 83 should, therefore, be allowable, as well.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

C. Independent Claim 68

Claims 68, 69, and 90-94, have been rejected under 35 U.S.C. § 102(c) allegedly being anticipated by U.S. Patent No. 6,492,815 B2 (“Hinks”).

Independent claim 68 has been amended to change “adapted” to “configured” as discussed above with respect to claim 19. Since it is clear from the prosecution history that the adapted element was meant to be a positive limitation, the scope of the claim has not been changed by this amendment.

As discussed in the May 1, 2006 Amendment, the device in Hinks is “placed inside a bore of an MRI system” (Col. 2, lines 19-23). No mechanical connection to the MRI system is shown, described, or needed. Hinks does not, therefore, show a fixture configured to be mechanically connected to the MRI system, as claimed.

Claim 68 and the claims dependent upon it should, therefore, be allowable.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

III. Conclusion


Allowance of the application in light of these Amendments and Remarks are respectfully requested.

Respectfully Submitted
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